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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,017	11/13/2001	Toshiyuki Sakurai	011441	6353

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EXAMINER	
AVELLINO, JOSEPH E	

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/987,017	SAKURAI ET AL.	
	Examiner	Art Unit	
	Joseph E. Avellino	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2001*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5-7,9,12,13 and 16-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 5-7, 9, 12, 13, and 16-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1, 5-7, 9, 12, 13, and 16-20 are pending for examination. The Office acknowledges the cancellation of claims 2-4, 10, 11, 14, and 15 and the addition of claims 16-20.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12, and 18 are rejected under 35 U.S.C. 101 because they are not tangibly embodied. All computer programs must be tangibly embodied in a computer readable medium in order for them to be patentable. See MPEP 2106.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 6, 13, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1, 6, 13, and 19 recite the limitation "a database configured to be written/read patient data of patients". It is unclear as to what the database is doing. For

examination purposes, it will be understood that the database is able to read and write patient medical data.

6. Claims 13, 19, and 20 recite the limitation of controlling or displaying "an inquiry mail and a reply mail in pairs". It is unclear what the meaning of this limitation is supposed to mean. For examination purposes, this will be understood linking an inquiry mail and a reply mail together.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 5-7, 9, 12, 13, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman et al. (USPN 5,995,939) (hereinafter Berman) in view of Akers et al. (US 2002/0169637) (hereinafter Akers).

8. Referring to claim 1, Berman discloses a linkage system which links a first computer of a first medical institution with a second computer of a second medical institution through a network (Figure 1, ref. 30-42),

wherein the first computer of the first medical institution comprising:

a communication terminal (i.e. client system 10) for sending out an email to the network and receiving an email from the network (col. 5, lines 31-62);

an inquiry file creating means for creating an inquiry basic data file having a patient information and inquiry contents (col. 5, lines 38-55);

an inquiry mail creating means for creating an email having the inquiry basic data file as an attachment file thereto (the Office takes the term "attachment" as "connected in some form") and addressing to the second computer (col. 5, line 54 to col. 6, line 39);

a reply contents output means for outputting reply contents being included in an attachment file of a received email in a predetermined mode (col. 6, line 45-52; col. 9, lines 9-42); and

wherein the second computer of the second medical institution comprising:

a communication terminal for sending out an email to the network and receiving an email from the network (col. 7, lines 50-62);

an inquiry contents output means for outputting inquiry contents being included in an attachment file of a received email in a predetermined mode (Figure 5; col. 8, lines 27-46);

a reply file creating means for creating a reply basic data file having an answer to the outputted inquiry contents (Figure 5; col. 8, line 47-57); and

a reply mail creating means for creating an email having the reply basic data file as an attachment file thereto and addressing to the first computer (e.g. abstract; col. 8, lines 20-53).

Berman does not specifically disclose a database configured to read and write patient data and medical treatment data, a data editor configured to edit medical treatment data based on data entry through an input device of the second computer,

and a reply file creator configured to create a reply file including the edited medical treatment data. In analogous art, Akers discloses another medical linkage system which discloses database configured to read and write patient data and medical treatment data (i.e. record client 104a and record server 102) (Figure 1), a data editor configured to edit medical treatment data based on data entry through an input device of the second computer (i.e. comment request system) (p. 7, ¶ 73-75), and a reply file creator configured to create a reply file including the edited medical treatment data (p. 7, ¶ 73-77). It would have been obvious to one of ordinary skill in the art to combine the teaching of Akers with Berman in order to enhance the system of Berman in order to allow the fulfillment legacy server user to provide commenting regarding a service request, thereby providing a further detailed medical record.

9. Referring to claim 5, Berman discloses the invention substantively as described in claim1. Berman does not specifically disclose each data item of the patient data is specified on data entry through the first computer, however Akers discloses encapsulating graphic image data such as x-rays, sonogram data or any other suitable data, which inherently must be entered using an input device (p. 4, ¶ 38). It would have been obvious to one of ordinary skill in the art to combine the teaching of Akers with Berman in order to enhance the system of Berman in order to allow the fulfillment legacy server user to provide commenting regarding a service request, thereby providing a further detailed medical record.

10. Claims 6-7, 9, 12, and 16-18 are rejected for similar reasons as stated above.

11. Referring to claims 13, 19, and 20. Berman and Akers do not specifically disclose creating an ID uniquely identifying the medical record, however this would be an inherent feature of the system, since each patient requires a different medical record and it would be necessary to create a unique ID for each file. It would also be inherent to create a unique ID for each request for comment for when the comments are replied to, and received by the originating sender, the computer can easily match them up for encapsulation and inclusion into the medical record data file. Furthermore this also reads upon the limitation "controlling an inquiry mail and a reply mail in pairs provided they have ID data corresponding to each other" since they are matched up for the medical record. As to displaying both the inquiry mail and reply mail in pairs, this would be obvious to one of ordinary skill in the art since it is well known that most email systems will regenerate the originating email when a reply is generated, therefore this would be obvious in order to allow the user to easily view all the data regarding this transaction.

Response to Arguments

12. Applicant's arguments with respect to claims 1, 5-7, 9, 12, 13, and 16-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality (i.e. *how the inquiry file and reply file are actually created*) that

allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA
June 15, 2005

DAVID WILEY
SUPERVISORY PATENT EXAMINER
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